

## REMARKS

Claims 1 - 8 remain active in this application. No additional amendments have been requested beyond those requested by preliminary amendment filed with the reissue application (referred to in the original reissue declaration) and no new matter has been introduced into the application.

The Examiner has requested that the specification be reviewed and any error found be corrected. The application, comprising a copy of the original patent, has been reviewed and no further errors beyond those for which this reissue application was filed to correct have been noted.

The Examiner asserts that the reissue oath/declaration is defective "because none of the errors relied upon to support the reissue application are errors upon which a reissue can be based". The Examiner further comments that the errors are merely listed as "amendment instructions" and that the declaration "fails to **specifically** identify the errors" and objected to, as distinguished from *rejected*, claims 1 - 8 for the same reason (emphasis in Examiner's action) and that the errors "appear to be mere editorial errors which would be correctable by Certificate of Correction. While this last observation by the Examiner is, indeed, appreciated, the Examiner's assertion that the reissue declaration is defective as to either substance or form is respectfully traversed.

While it is acknowledged that the errors sought to be corrected might properly be considered to be non-substantive and editorial in nature since the errors (and the need therefor) can be discerned from the claims as allowed and correction is not intended to alter the scope of the issued claims, the contrary conclusion(s) are certainly believed to be arguable and may result in the patent being considered to be wholly

or partly inoperative or invalid, as stated in the reissue declaration. The errors involve antecedent language correspondence, logical correspondence of terminology with accepted usage in the art and (in view of other requested changes) further limitations of claims in dependent claims; all of which may be grounds for rejection or finding of invalidity due to indefiniteness, particularly as to the scope of the claims. (It is also respectfully pointed out in this regard that any arguable issue of increased breadth of the claims engendered by the requested amendments is moot in view of the filing of this reissue application within two years of the patent issue date over the declaration of the inventors rather than the assignee.)

For example, in claim 1, it is sought to change "number of bits of said *number*" to "number of bits of said *length*" since the proper antecedent language for this recitation is, in fact, "length" and, moreover, the phrase, as allowed and patented may be self-referential. This correction requires a similar correction later in the claim. Further in claim 1, there is no antecedent language for "said image data" (which further defines "code" or "code word" in dependent claim 3 and the clearly intended antecedent in claim 1 is, in fact, "code word". Any of these errors, though readily detectable and the proper correction readily discernible might also be the basis for rejection or a determination of invalidity under 35 U.S.C. §112, second paragraph. It is also respectfully submitted that only one such error need exist to fully support reissue, as noted in M.P.E.P. §1402.

Therefore, it is respectfully submitted that the recitation in the reissue declaration that the patent is *believed* to be wholly or partially inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim", together with a recitation of the changes sought to be made seems to be

entirely adequate, appropriate and accurate to the corrections sought. It is also respectfully pointed out that the patentee's *belief* in this regard (M.P.E.P. §1402, cited by the Examiner, uses the term "deemed" to apparently convey the same meaning), as attested by the reissue declaration of record (i.e. that the patent *may* be wholly or partially inoperative or invalid, even though the requested changes could be considered to be editorial), is entirely sufficient and all that is required by 37 C.F.R. §1.175(a)(1). There is no requirement that Applicants specify any particular constructions of the claim language which would alter the intended scope of the claims.

(That the errors arose without deceptive intention on the part of the Applicant, as required by 37 C.F.R. §1.175(a)(2) to which the reissue declaration also attests, is also implicit from the circumstances leading to this reissue application. The errors sought to be corrected were submitted by a timely filed amendment under 37 C.F.R. §1.312 which was not acted upon by the USPTO, as detailed in the remarks appended to the preliminary amendment, also acknowledged in the reissue declaration, and the failure of the USPTO to consider the amendment and to issue a Certificate of Correction *sua sponte* in response thereto.)

Further, particularly in the context of these circumstances, it is respectfully submitted that there is no format (at least none apparent to the undersigned) for presentation of the errors in the reissue declaration which could provide an identification of the errors sought to be corrected which could be any *more* specific thereto. In this regard, Applicants would be pleased to provide any Supplemental Declaration containing any language consistent with the circumstances which may be suggested by the Examiner and which emphasizes the possibility of the patent being wholly or partially

invalid by reason of the errors sought to be corrected. However, it is respectfully submitted that there is no authority in the Statute, Rules or M.P.E.P. for *requirement* of an declaration attesting to anything more than is contained in the reissue Declaration of record.

Accordingly, it is respectfully submitted that the original reissue declaration clearly meets all requirements of 37 C.F.R. §1.175 and no basis exists for objection to the claims as being inadequately supported by the reissue declaration. Moreover, there is no basis in the Statute, Rules or M.P.E.P. for denying reissue based upon the Examiner's determination that the requested changes are or may be *de minimis*, even though that view may be shared by Applicants. It is respectfully submitted that the operative question is whether or not the reissue Applicants *believe* the patent *may be* wholly or partly inoperative or invalid due to errors which would be corrected by the changes requested as is clearly at least arguable as pointed out above and at length in the remarks appended to the preliminary amendment filed with the original reissue application. Further, it is believed that, under the present circumstances, a request for a Certificate of Correction *by Applicant* would not provide an appropriate remedy for the possibility of the patent being wholly or partly inoperative under 35 U.S.C. §112, even if granted, since such granting of a Certificate of Correction might not carry the same presumption of validity, based on substantive examination, as the correction of errors by grant of reissue (to which the patentees are entitled and which they believe may be compromised by the errors sought to be corrected by this reissue application). Moreover, since the filing of this reissue application is largely the result of error(s) by the USPTO in failing to properly and timely consider the timely filed amendment

under 37 C.F.R. §1.312 in the application which matured into the patent for which reissue is sought, the USPTO should not insist upon lesser remedies than those to which Applicants/Patentees are clearly entitled in this reissue application.

Since all objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0457

Respectfully submitted,



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